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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,102	07/09/2003	Hans Schmotzer	MEISS71.007DV1	1655

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/06/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/06/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/616,102

Applicant(s)

SCHMOTZER ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24,25 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio (5810831). Fig. 1 shows a slideway with two convexly curved condyles and inherently has a patella shield. Fig. 2 illustrates that the femur has two holes drilled for pegs located on the slideway. D'Antonio discloses that surgeons remove more bone from the dorsal side of the femur than replaced by the slideway, col. 1, lines 53-64. D'Antonio also discloses (col. 5, lines 40-42) using a template to size the femur and shows (Fig. 2) at least one bore 60 separated by a pre-determined distance. The use of "permanently specified distance" is terminology of relative degree, which has no basis of comparison. For this reason, it is considered broad and relatively unlimited in how it can be interpreted. It could be "a permanent measurement" for each patient that defines the "pre-determined distance". It is inherent that the surgeon is going to locate a point to drill a hole. It is also inherent that the slideway is fitted onto the femur and that pegs are inserted into the holes formed in the femur. Fig. 5 shows the femoral preparing apparatus forming a template includes a support 22 and flank 26 having a contact surface to engage the dorsal points of condyles of a femur. Clearly the support and flank function as a single piece during use so that the surgeon obtains the exact location

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for the drilling of the hole to receive a peg since multiple piece structures should be designed to remain integral during a surgery.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims are 1,2,5,6,16,18,19,22,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831. D'Antonio is explained supra. However, D'Antonio fail to disclose the template having the support part and flank that contacts the dorsal part of the condyles of the femur constructed as a single or integral piece. It would have been an obvious expedient to simplify the construction of a template and form the support and contacting flank surface as a single piece such that there is a secure attachment to the femur when sizing and preparing the femur for the prosthesis. Constructing a single piece component from formerly separate elements involves only routine skill in the art.

Claims 3,4,7,17,20,21,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831. D'Antonio is explained supra. However, D'Antonio fails to disclose the pre-determined distance between the condyles and a point located on the femur being "about" 5-15% larger than the dimension of the between the peg and prosthesis condyles. It would have been an obvious matter of design choice to modify the amount of slideway surface provided for articulation, since applicant has not disclosed that using a larger amount provides any advantage, or solves a stated

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problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with distance provided in the preparation of the femur taught by D'Antonio or the claimed 10% in claim(s) 4,10,21 because both procedures perform the same function of taking into consideration the anatomy conditions of the patient and the articulation of the prosthesis with respect to the ligaments. With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a slideway having about 2-5% dimension of a distance between a dorsal sliding surface and a ventral sliding surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to resect about 10% more bone from the dorsal side of the femur, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831 in view of Colleran et al. (5776201). D'Antonio is explained supra. However, D'Antonio fails to disclose providing a group of slideways with different dorsal condyle-to-ventral condyle distances. Colleran et al. teach (Fig. 4) a group of slideways is provided in a surgical procedure to prepare a femur for implanting a prosthesis. Colleran teaches the femoral prostheses are different sizes, col. 2, lines 54-56. It would have been obvious to one of ordinary skill in the art to use a plurality of femoral prostheses as

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taught by Colleran et al. in D'Antonio's method of surgery on a femur such that the surgeon has a proper fitting prosthesis for the patient since all patients are going to have different anatomical features.

Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831 in view of Ries et al. (5549688). D'Antonio is explained supra. However, D'Antonio fail to disclose the bone material removed is done to reduce the load on ligaments attached to the femur. Ries et al. teach that removal of bone is greater than the slideway such that it reduces the load on the ligaments and balancing the strain relationship with the prosthesis and bone, col. 1, lines 43-45, col. 4, lines 51,52. It would have been obvious to one of ordinary skill in the art to use more bone removal to match the contour of the femoral anatomy than replaced with the slideway as taught by Ries et al. in the method of preparing the femur for the prosthesis of D'Antonio such that it reduces the load on ligaments attached to the femur. Regarding claim 10, it would have been an obvious matter of design choice to modify the amount of slideway surface provided for articulation, since applicant has not disclosed that using a larger amount provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with distance provided in the preparation of the femur taught by D'Antonio as modified by Ries et al. or the claimed 10% in claim(s) 10 because both procedures perform the same function of taking into consideration the anatomy conditions of the patient and the articulation of the prosthesis with respect to the ligaments. With respect to claims 11-15, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to use a distance between the peg and dorsal sliding surface of the slideway having a range between 24-34mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claims 9-15 have been considered but are moot in view of the new ground(s) of rejection. Applicant argued that the template of D'Antonio is formed with separate components making the contact flank surface and the support. However, the new limitation is addressed above in that the Examiner has taken the position that it is well within the level of ordinary skill in the art to simplify or make elements of apparatus as a single piece or integrally.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 8am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

Brian E Pellegrino